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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,929	08/23/2001	Carl Alexander Kamb	20410-7001	9809
7590	09/08/2003			
Michael Shuster McCutchen, Doyle, Brown & Enersen, LLP Three Embarcadero Center San Francisco, CA 94111			EXAMINER RAWLINGS, STEPHEN L	
			ART UNIT 1642	PAPER NUMBER 11
			DATE MAILED: 09/08/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)
	09/935,929	KAMB, CARL ALEXANDER
	Examiner Stephen L. Rawlings, Ph.D.	Art Unit 1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 March 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>10</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <i>Election facsimile cover sheet</i> . |

DETAILED ACTION

1. The amendment filed March 8, 2002 in Paper No. 8 is acknowledged and has been entered.
2. Claims 1-28 are pending in the application and are currently subject to the following restriction.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-12 and 15-25, insofar as the claims are drawn to a method for identifying a cell-specific cis-regulatory element, wherein said cell is a mammalian cell, classified in class 435, subclass 325+.

Group II. Claims 1-3, 5-8, 13, and 15-25, insofar as the claims are drawn to a method for identifying a cell-specific cis-regulatory element, wherein said cell is a plant cell, classified in class 435, subclass 410+.

Group III. Claims 1-3, 5-8, and 14-25, insofar as the claims are drawn to a method for identifying a cell-specific cis-regulatory element, wherein said cell is a microbial cell, classified in class 435, subclass 243+.

Group IV. Claim 26, drawn to a method for characterizing one or more protein factors that bind to an identified cell-type specific cis-regulatory element, classified in class 435, subclass 6.

Group V. Claims 27 and 28, drawn to a method for identifying a novel host cell sequence variant, classified in class 435, subclass 325+, for example.

Art Unit: 1642

4. The inventions are distinct, each from the other because of the following reasons:

The inventions in groups I-V are disclosed as materially different methods that differ at least in objectives, method steps, reagents and/or doses and/or schedules used, response variables, assays for end products and/or results, and criteria for success, and therefore the claimed methods are distinct.

5. Because these inventions are distinct for the reasons given above and also because the search required for any one group is not required for any other group and/or the inventions have acquired a separate status in the art as shown by their different classification or their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Claims 1 and 3 are generic to a plurality of disclosed patentably distinct species of invention wherein said developmentally related cell types are selected from the group consisting of (a) breast cancer cells and normal mammary epithelial cells, (b) lung cancer cells and normal lung epithelial cells, (c) colon cancer cells and normal colon epithelial cells, (d) ovarian cancer cells and normal ovarian cells, (e) melanoma cells and normal melanocytes, (f) leukemia cells and normal leukocytes, (g) prostate cancer cells and normal prostate cells, and (h) metastatic cells and non-metastatic cells. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Claims 1 and 7 are generic to a plurality of disclosed patentably distinct species of invention wherein said preselected agent is selected from the group consisting of (a) retinoic acid, (b) estrogen, (c) insulin, (d) progesterone, (e) growth factors, (f) cytokines, and (g) nutrients. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

7. Should Applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.
Examiner
Art Unit 1642

Stephen Rawlings
STEPHEN RANLINGS

slr
September 3, 2003



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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